

INVENTOR: Desai et al.

S/N 09/682,843

FINALITY OF OFFICE ACTION

The Examiner has made the Office Action dated October 22, 2003 final. Applicant believes the finality of the Office Action is in error. In the Office Action Summary, the Examiner indicates that claims 10-21 and 28-30 are allowed. Similarly, on page 4 of the Office Action, the Examiner states under the heading, Allowable Subject Matter, that claims 10-21 and 28-30 are allowed, however, on page 2 of the Office Action the Examiner has rejected claim 30 under 35 U.S.C. §112, second paragraph. Applicant is unclear whether claim 30 stands allowed or rejected.

Additionally, the Examiner rejected claim 31 under 35 U.S.C. §103(a) as being unpatentable over Wang in view of OMEGAMARKER®. Claim 31, as presented, is the subject matter of original claims 1, 7, and 8. In the Office Action dated February 27, 2003, the Examiner indicated that claim 8, which depends from claim 7, which depends from claim 1, to be allowable over the art of record as the art of record fails to teach or suggest a dual temperature indicator stick wherein the union ends of the first and second elements thread with each other. The Examiner has now rejected claim 31 based on art already of record. As such, Applicant has not been afforded an opportunity to respond thereto. As such, at least for those reasons set forth above, Applicant believes the finality of the Office Action dated October 22, 2003, is improper. Therefore, Applicant requests that the finality of the Office Action be withdrawn.

REMARKS

Claims 1-31 are pending in the current application. In the Office Action mailed October 22, 2003, the Examiner rejected claims 6 and 30 under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner next rejected claims 1, 3-4, 7-9, 22-26, and 31 under 35 U.S.C. §103(a) as being unpatentable over Wang (USP 6,290,413) in view of OMEGAMARKER® Temperature Test Kit (hereinafter OMEGAMARKER®). Applicant appreciates the allowance of claims 10-21 and 28-30 and the indication of the allowability of claims 2, 5, and 27.

The Examiner rejected claims 6 and 30 under 35 U.S.C. §112, second paragraph, stating that the claims are incomplete for "omitting essential structural cooperative relationships of elements" specifically, "the relationship between the collet and the

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connector.” The Examiner further states that “this relationship is essential for the operation of the claimed assembly and should be set forth in the claim language in order to provide a clear description of the claimed assembly.” The Examiner cites MPEP §2172.01 to support the rejection. The Examiner cannot determine what is essential to the invention. MPEP §2172.01 states that “... a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph...” (emphasis added). That is, the Examiner cannot merely dictate what is essential to the invention and impose rejections in response thereto. Claims 6 and 30, each individually, further define that which is called for in the claims from which they depend. There is no disclosure in the specification of any one element being essential to the invention. As Applicant has not defined any one element as essential to the invention, it is improper for the Examiner to impose such a requirement upon the Applicant. Claims 6 and 30 satisfy the requirements of 35 U.S.C. §112. Therefore, for purposes of appeal, Applicant requests that the Examiner provide a detailed explanation of the rejection, or withdraw the rejection.

The Examiner rejected claims 1, 3, 4, 7-9, 22-26, and 31 under 35 U.S.C. §103(a) over Wang in view of OMEGAMARKER® Temperature Test Kit (hereinafter OMEGAMARKER®) stating that “Wang shows a dual crayon holder assembly comprising: a first crayon [30], a second crayon [30] and a connector [10] physically connecting the first and second crayons in a single assembly such that each crayon is independently operable i.e., only one crayon is used at a time.” Applicant does not disagree that the crayons of Wang can only be used one at a time. That is, as one crayon is extended from the connecting device, the second crayon is retracted into the connecting device. This is not what is called for in claim 1. Claim 1 calls for, in part, a connector physically connecting a first and second indicator sticks in a single assembly such that the first and second indicator sticks are independently operable thereto. The “thereto” called for in claim 1 modifies “independently operable” to define that both the first and second indicator sticks are independently operable to the assembly. Each of the first and second indicator sticks is “independently operable”. Such is not the case in Wang. As the

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Examiner admits, only one crayon of Wang is used at a time. That is, the crayons of Wang are not independently operable to the connector. Each crayon is dependent on the position of the other crayon.

Additionally, there is no disclosure in Wang that the writing instrument disclosed therein is constructed to indicate any temperature, let alone two different temperatures. The burden of establishing a prima facie case of obviousness falls on the Examiner. MPEP §2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a prima facie case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). That is, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP § 2143.01. "The fact that references can be combined or modified is not sufficient to establish prima facie obviousness." *Id.* When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

To establish a prima facie case of obviousness, one of the basic criteria that must be satisfied is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP §2143. Applicant believes that a prima facie case of obviousness cannot be made based on the art of record

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because the references are directed to very different purposes and there is no motivation to combine these references in a way done so by the Examiner, other than Applicant's own teaching. The Examiner has not established at least the first of the three basic criteria required under MPEP §2143. Simply put, absent the teaching of the present application, neither Wang nor OMEGAMARKER®, either individually or in combination, suggest or motivate the combination of two temperature indicating sticks into a single assembly. Therefore, at least for the reasons set forth above, Applicant believes claims 1-32 are patentably distinct over the art of record.

Notwithstanding the arguments above, Applicant has amended claim 22 to clarify that which was previously added thereto. As such, claim 22 has been amended to incorporate the subject matter of original claim 25. Claim 25 is cancelled. As amended, claim 22 calls for, in part, defining the connecting of the first and second indicator sticks in a single assembly wherein the single assembly permits movement of the first indicator stick independent of the second indicator stick. It is clear that the writing instrument as shown in Wang does not permit the movement of the first crayon independent of the second crayon. As Wang states, "the user can move the t[h]rust device (40) to drive the connecting device (20) back and forth to make the writing implement (30) extend through the end-piece (50) or retract into the barrel (10)." Col. 2, lns. 48-51. That is, as one writing implement is extended from the barrel the second writing implement is retracted into the barrel. As such, the writing instrument of Wang does not permit the movement of the first writing implement independent of the second writing implement.

Additionally, as previously stated, there is no suggestion or motivation in Wang or OMEGAMARKER® to combine the writing instrument of Wang with a temperature indicator of OMEGAMARKER®. Further, there is no suggestion or motivation to combine the writing instrument of Wang with a first and a second temperature indicating element. Therefore, Applicant believes claim 22, and those claims that depend therefrom, are patentably distinct over the art of record. As claim 22 has been amended to incorporate the subject matter of a claim that originally depended therefrom, specifically, the subject matter of claim 25, the amendment to claim 22 does not add new matter or require additional search or consideration.

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The Examiner rejected claim 31 under 35 U.S.C. §103(a) over Wang in view of OMEGAMARKER® stating that "the connector comprises first element [10 connected to 50 as shown in Figure 1] and a second element remaining end piece [50] shown in Figure 1." Notwithstanding the lack of motivation to combine the references discussed above, Applicant has amended claim 31 to clarify that which is called for therein. Claim 31 has been amended to call for, in part, each of the first and second elements of the connector have a marking end and a union end wherein each union end of the first and second elements extend beyond an end of the respective indicator stick housed therein. End piece 50, considered to be the second element by the Examiner, does not house a crayon therein, rather, crayon 30 passes through end piece 50 and engages connector 23. As such, a "union end" of end piece 50 does not extend beyond an end of the respective indicator stick housed therein. As such, Applicant believes that which is called for in claim 31 is patentably distinct over the art of record.

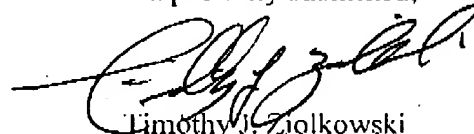
New claim 32 contains the subject matter of allowable claim 27. As such, Applicant believes claim 32 to be patentably distinct over the art of record.

Therefore, in light of the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-32.

A credit card authorization in the amount of \$104.00 is enclosed for fees associated with entering the claim newly presented herein.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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